

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q90407

Masahiro HAGIWARA, et al.

Appln. No.: 10/550,259

Group Art Unit: 1794

Confirmation No.: 1176

Examiner: Dhirajlal S NAKARANI

Filed: September 21, 2005

For: TIN-DOPED INDIUM OXIDE FINE PARTICLE DISPERSION , METHOD FOR MANUFACTURING THE SAME, INTERLAYER FILM FOR LAMINATED GLASS WITH HEAT RAY BLOCKING PROPERTIES FORMED BY USING SAID DISPERSION, AND LAMINATED GLASS THEREWITH

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

ATTN: Technology Director

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants submit that the finality of the Office Action dated December 23, 2008 is improper and thus Applicants respectfully solicit withdrawal of the finality of the Office Action.

Specifically, the first Action after an RCE may only be made final under the following circumstances.

MPEP § 706.07(h)(VIII) states:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 C.F.R. § 1.114 may be made final *only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met* (emphasis added).

MPEP § 706.06(b) states:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) *all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application* (emphasis added).

In the present case, with respect to (1) above, all of the claims presented in the Rule 114 Amendment are not drawn to the same invention claimed in the application prior to entry of the Rule 114 Amendment. For example, the invention as recited in claim 1 prior to entry of the Rule 114 Amendment did not require that the dispersion stabilizers comprise three components: (1) a chelate, (2) an organic acid; and (3) at least one selected from the group consisting of a sulfate ester-based compound, a phosphate ester-based compound and a polyvinyl alcohol. Prior to entry of the Rule 114 Amendment only two components were required for the dispersion stabilizers: (1) at least one selected from the group consisting of a sulfate ester-based compound, a phosphate ester-based compound, a ricinoleic acid, a polyricinoleic acid, a polycarboxylic acid, a polyhydric alcohol surfactant, a polyvinyl alcohol and a polyvinyl butyral; and (2) at least one selected from the group consisting of a chelate, an inorganic acid and an organic acid. Additionally, the scope of the dispersion stabilizers has been changed by the Rule 114 amendment. Thus, for at least these reasons, the finality of a first Action after filing an RCE is improper.

In a telephone conversation with the Examiner, conducted on February 11, 2009, Applicant requested that the Examiner reconsider the finality of the outstanding Office Action.

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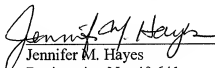
Attorney Docket No.: Q90407

The Examiner stated that he will consider the request and withdraw the finality if appropriate. In response, Applicants submit this petition.

For the reasons discussed above, Applicants respectfully request that the finality of the Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: February 20, 2009